



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/777,614	02/05/2001	Christopher P. Bergh	10235-048001	6722

26161 7590 12/29/2010
FISH & RICHARDSON P.C. (BO)
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

EXAMINER

ALVAREZ, RAQUEL

ART UNIT	PAPER NUMBER
----------	--------------

3688

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

12/29/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

Office Action Summary	Application No. 09/777,614	Applicant(s) BERGH ET AL.	
	Examiner Raquel Alvarez	Art Unit 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/3/2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-29,31-38 and 44-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-29,31-38 and 44-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to communication filed on 11/3/2010.
2. Claims 17-29, 31-38 and 44-46 are presented for examination.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claim 17-29, 31-38 and 44-46 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 11/549,797 because both applications recite data processing rules being a set of time based rules, the time based rules including at least one of a direct rule that immediately instantiates offers based on an offer campaign, a triggered rule that instantiates offers based on the occurrence of particular conditions, and a stored rule that instantiates offers based on user interaction with previous offers

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 17-29, 31-38 and 44-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benthin al. (2002/0035568 hereinafter Benthin) in view of Langseth et al. (6,694,316 hereinafter Langseth).

With respect to claims 17, 19-20, 25-27, 31, 33, 35-36, 44 Benthin

teaches a computer-controlled method for managing and distributing offers (abstract). Producing a marketing campaign comprising a plurality of offers specified by offer data processing rules, executed by the computer, from which one or more of the offers are identified for targeting specific individuals being a set of time based rules, the time based rules including at least one of a direct rule that immediately instantiates offers based on an offer campaign, a triggered rule that instantiates offers based on the occurrence of particular conditions, and a staged rule that instantiates offers based on user interaction with previous offers (i.e. controlling the presentation of when to transmit the offers to the customers, paragraphs 0031 and 0041 teaches automatic offers that are presented right away; paragraph 0030 teaches presenting the offers if it fit the customer profile and paragraph 0024 teaches the customer clicking on ads to determine which campaign of offers to present to the customer)(see also Figure 1);

selecting one of the time based rules to determine a subsequent set of offers to send the specific individuals (see paragraph 0036);

prioritizing by the computer the set of offers for an individual, with prioritizing being to determine which offer or offers from the set of offers should be sent to the individual from multiple offers associated with the individual and selecting a prioritized offer from the prioritized offers for presenting to the individual associated with those prioritized offers(see presentation parameters 14).

With respect to delivering the offers to the individuals over one of a plurality of

Art Unit: 3688

different types of delivery channels associated with the offer. Langseth teaches selecting the advertisements or offers based on the capability of the channels to the selected offers. Langseth teaches selecting from a plurality of channels which advertisements to place based on the channel capacity and content of the channel. Langseth, clearly teaches in step 928, the advertisements being selected based on the channel being run or the capacity of the channel. Each channel accommodates or is capable of outputting different types of ads. For example, a golf site may only enable access to a sports channel. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included in the system of Benthin the teachings of Langseth of presenting the offers to the individuals over one of a plurality of delivery channels associated with the offer because such a modification would **"provide a readable available medium for delivery of the right information at the right time"** (Langseth col. 3, lines 6-10).

Claims 18, 23-24, 34 further recite determining a channel to select based on user response to an offer. Official Notice is taken that it is old and well known in marketing to determine how well users response to ads on TV versus ads in the radio in order to select how the ads are going to be delivered based on the user's responses. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included determining a channel to select based on user response to an offer in order to allow the advertisers to determine the best delivery medium.

Claims 21-22, 37-38 further recite the capacity of the channels being related to the monetary cost of the channel. Official notice is taken that it is old and well known for monetary and operating cost being related to the capacity of the channels. For example, CNN will have a higher capacity than a local smaller channel with a smaller budget. It would have been obvious to have included the capacity of the channels being related to the monetary cost of the channel because such a modification would allow the channels to invest and better maintain the channels in order to have a higher chances of being selected.

With response to claims 28-29, 32 and 45-46, Benthin further teaches reporting the effectiveness of the plurality of offers and presenting a sequence of related offers to those individuals based on the individuals activities (i.e. tracking offers effectiveness in order to further target further offers to the individuals)(paragraphs 0082-0088)

Response to Arguments

7. The Double Patenting rejections have been maintained since a Terminal disclaimer hasn't been filed.

8. Applicant argues that Benthin describes identifying the schedule and frequency for a campaign and that in contrast, claim 17 calls for selecting one of the time based rules to determine a subsequent set of offers to send to the specific individual. The Examiner disagrees with Applicant because The Examiner disagrees with Applicant because Benthin teaches different time to present the offers to the customer

such as certain offers are presented right away (i.e. specify the content to be automatically presented to the specific customer on paragraph 0031) , other offers are presented based on the timing of a certain conditions, such as the user clicking on certain ads (i.e. clicking on a link on paragraph 0024) and in addition certain offers presented in stages such as building a customer profile and then presenting different offers to the customers (i.e. offers based on customer's profile, paragraph 0024). As can be seen by Benthin above, Benthin teaches subsequent offers specific to certain condition that must be met by the offers to whom the offers are sent at the time such as what the users are currently clicking on, user's profile etc.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Point of contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (571)272-6715. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571)272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Raquel Alvarez/
Primary Examiner, Art Unit 3688

Raquel Alvarez
Primary Examiner
Art Unit 3688

R.A.
12/20/2010